REMARKS

Claims 23-42 are pending. The Office Action rejects claims 23-42. Applicants amend claims 35 and 40-42. No new matter is added.

Applicants request the Patent Office to acknowledge Applicants' claim for foreign priority and receipt of the certified copies of the priority documents (4), as filed in the parent application.

I. REJECTION UNDER 35 U.S.C. § 112

Claims 34-35 were rejected under 35 U.S.C. § 112, first paragraph.[1/] The Office Action alleges that the specification does not provide written description support for the "sixth and seventh supplying means".

Applicants traverse this rejection.

The sixth and seventh supplying means is described, for example, at page 37, lines 7-14 ("At this time, permeated water is measured by a flow meter 43, and dispersion that underwent the ultrafiltration is returned to the tank 40 for ultrafiltration process. Further, pure water is supplemented to the tank 40 for ultrafiltration process, and its flow rate is measured by a flow meter 44.") and Fig. 3 (showing first storage means 38, second storage means 40 and ultrafiltration module 42).

Claims 34-35[2/] were rejected for citing the limitation "sixth" and "seventh". The Examiner alleges that there is insufficient antecedent basis for such limitations in the claims.

[1/] The Office Action appears to have inadvertently rejected claims 34-25. Applicants believe that the Office Action is referring to Claims 34 and 35.

[2/] The Office Action appears to have inadvertently rejected claims 35-36. Applicants believe that the Examiner is referring to claims 34 and 35.

Applicants traverse the rejection with respect to claim 34 and amend claim 35. In particular, claim 34 incorporates the limitations of claim 31, and further comprises "a sixth supplying means". Thus, the format of claim 34 is correct. Claim 35 is amended to delete the word "seventh."

For at least the forgoing reasons, instant claims 34-35 are adequately supported by the specification, and have proper antecedent basis. Reconsideration and withdrawal of the rejections are earnestly solicited.

II. REJECTIONS UNDER 35 U.S.C. § 102(e)/§ 103(a)

Claims 40-42 were rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Kawanishi et al (U.S. Patent No. 6,472,546; hereafter "Kawanishi"). The Office Action alleges that the apparatus taught in Kawanishi is the same at that claimed in instant claims 40-42. The Office Action further notes that Kawanishi and the claimed invention work similarly such that if instant claims 40-42 are not anticipated, they would have been rendered obvious over Kawanishi.

Applicants traverse this rejection and amend each of claims 40-42 to recite "a pipeline for supplying a dispersion after ultrafiltration from a purification means." The examiner has acknowledged the absence of this feature in Kawanishi. (See Office Action, page 3, paragraph 9.) In this regard, Kawanishi does not anticipate Claims 40-42. With regard to the rejection under 35 U.S.C. § 103(a), the instant application and Kawanishi were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person, namely, FUFIFILM Corporation. Kawanishi is therefore disqualified as a reference under 35 U.S.C. § 103(c), and thus is disqualified for use in an obviousness rejection as prior art under 35 U.S.C. § 102(e)/35 U.S.C. § 103(a).

For at least the foregoing reasons, instant claims 40-42 are patentable over Kawanishi. Reconsideration and withdrawal of the rejection are earnestly solicited.

III. REJECTION UNDER 35 U.S.C. § 103(a)

Claims 23-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kawanishi and Kuno et al (U.S. Patent No. 6,630,293). The Office Action asserts that Kawanishi discloses an apparatus for forming a silver salt of an organic acid substantially as claimed, except for a purification means, which is allegedly disclosed in Kuno et al.

This rejection is moot due to its reliance upon Kawanishi, which has been disqualified for use in the obviousness rejection, as discussed above. Moreover, Kuno et al would not have rendered obvious instant claims 23-39 on its own.

For at least the foregoing reasons, instant claims 23-39 are patentable over Kawanishi and Kuno et al. Reconsideration and withdrawal of the rejection are earnestly solicited.

IV. NON-STATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 23-42 were rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,818,190 to Kawanishi et al. (hereafter "Kawanishi '190").

In response, the common Assignee submits herewith a Terminal Disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior Patent No. 6,818,190 to Kawanishi.

Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

In view of the foregoing, claims 23-42 are patentable. Reconsideration and withdrawal of the rejection are earnestly solicited.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The U.S. Patent and Trademark Office is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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